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PATENT
CASE NAME/No.: SP02-194

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Inventor: ROUX STEPHANE, et al.

Serial No: 10/667530

Art Group Unit: 1713

Filing Date: 9/22/2003

Examiner: Pezzuto, Helen Lee

Title: NEW VERY LOW-LOSS POLYMER
MATERIALS

RESPONSE

Commissioner for Patents
Alexandria, VA 22313-1450

RESPONSE TO EXAMINER'S RESTRICTION REQUIREMENT

In the Office Action dated September 9, 2004, designated as Paper No./Mail Date 09/09/2004 in the above-captioned application, the Examiner issued a Restriction Requirement identifying the following groups of claims as being drawn to potentially distinct inventions:

Group I. Claims 1-2, drawn to a compound/monomer, classified in class 540, subclass 1+;

Group II. Claims 9-20, drawn to a composition, classified in class 526, subclass 258+.

The Examiner asserted that these inventions may be regarded as independent and distinct from one another because the "intermediate" product of Group I is useful to make other final products (Applicant's Group II), and for other reasons as set forth in the office Action.

Applicants elect prosecution of the Group I claims 1-8 with traverse. Provisionally, pending the Examiner's reply to the traverse and subsequent withdrawal of the restriction requirement, the Group II claims are withdrawn from consideration. The withdrawal will be confirmed in the response to the subsequent office Action in the event the Examiner rejects the traverse. Applicants reserve the right to file a divisional application on the invention of claims 9-20 without loss of priority.

Applicants respectfully traverse the Examiner's Restriction Requirement on the grounds it is clear from the specification and claims themselves that the compounds of claims 1-8 can, of themselves, constitute the energy curable composition of claims 9-20. The Examiner's statement is also unclear as to what is meant by "the intermediate product is useful to make other than the final product".

Applicants have clearly indicated that the "intermediate" compound can itself be energy cured as set forth in claims 9-20. Claim 9 clearly states that one may "optionally" include a catalyst and a second monomer with the compositions of the Group I claims to form an energy curable material. Their inclusion is not required as the Examiner seem to believe. Applicants refer the Examiner to Paragraph [0019] that clearly states:

The compounds of the invention are energy polymerizable. Energy polymerizable means that they can be polymerized either alone or in combination with other polymerizable compounds by application of heat, actinic radiation or electron beam radiation to form homopolymers and/or copolymers.

Applicants submit that the fact that additional polymerizable substances, and a polymerization catalyst, may optionally be used with the compounds of claims 1-8 does not of itself make the invention of claims 9-20 distinct from that of claims 1-8 distinct from those of 9-20. The compounds of claims 1-8 may of and by themselves constitute the polymerizable composition of claims 9-20.

Applicants respectfully submit that in view of the foregoing facts and the optional nature of both the second monomer and the catalyst, the claims of Group I and Group II are not two distinct inventions as set forth by the Examiner.

Therefore, applicants respectfully submit that it is proper for the Examiner to withdraw the restriction requirement in the next subsequent Office Action, and continue prosecution of Groups I claims 1-8 and Group II claims 9-20 together with one another.

In Section 4 on page 3 of the Office Action the Examiner is believed to indicate that a species election is required. If this is correct with regard to the Group I claims, applicants

here make this election for Group I **with traverse** to the entire requirement for a species election.

First, applicant is uncertain as to what respect a species election is to be made. Chemical claims frequently are directed to a "backbone structure" that can contain a variety of substitutes (hence rise of the Markush claim). Applicant believes that claim 1 as presently presented falls within normal chemical claim practice and does not require election of a "species".

Claim 1 sets forth the formula $H_2C=CH-C_6X_{4-n}Z_n$. The moiety $H_2C=CH-C_6X_{4-n}$ is believed clear and not requiring any "election" due to the fact that $-C_6X_{4-n}-$ represent a substituted benzene ring with the substituents being as indicated in the claims. Therefore any election must be to "Z".

Assuming that the species election must be made with regard to "Z", applicants are uncertain to which of Y, W and U such election must be made. Assuming that the election is to be made with regard to W because Y and U (when present as S, O or NH) are known to be used for linking two chemical moieties (e.g., ethers, thioethers, diamines), applicants do not understand how the election is to be made. However, to be fully responsive, applicant would elect W as being 5 and 6 member heterocyclic aromatic and polycyclic-heterocyclic compounds and halogenated derivatives thereof. However, the elected species are similar to the aromatic and polycyclic aromatic ring also set forth in claim 1. Applicants do not believe a species election is appropriate in the present case as all the compounds are clearly related to what is set forth in the basic equation.

The undersigned attorney requests that the Examiner call him if necessary so that the "species election" requirement can be discussed and clarified.

Applicants believe that no extension of time is necessary to make this Response timely. Should Applicants be in error, Applicants respectfully request the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said

time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Walter M. Douglas at 607-974-2431.

8 October 2004

Date

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I hereby certify that this paper and any papers referred to herein are being transmitted by facsimile to the U.S. Patent and Trademark Office at 703-872-9306 on:

8 October 2004

Date

Walter M. Douglas 8 Oct 2004

Walter M. Douglas

Date

Respectfully submitted,
CORNING INCORPORATED

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